

REMARKS

By this Amendment, new claims 139 and 140 have been added. No new matter has been added by this amendment. Accordingly, claims 50, 53-55, and 119-140 are pending in this application. Of these claims, claims 131-134 were previously withdrawn.

In the outstanding Office Action, the drawings were objected to based on informalities; claims 121 and 122 were objected to based on informalities; claims 50, 53-55, 119-128, 129, 130, and 135-138 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement, and were also rejected under 35 U.S.C. § 112, second paragraph, as being indefinite; claims 50, 53-55, 119-128, 129, 130, and 135-138 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,040,359 to Thimon ("Thimon"), in view of U.S. Patent No. 4,807,427 to Casteel et al. ("Casteel").

Objection to the Drawings

In accordance with the Examiner's instructions from page 2 of the outstanding Office Action, Applicants file herewith ten replacement drawing sheets (FIGS. 1, 2A, 2B, 2C, 3, 5A, 5B, 8, 9, 10, 11) to replace FIGS. 1, 2A, 2B, 2C, 3, 5A, 5B, 8, 9, 10, 11 in the above-identified application. If the replacement drawing sheets for any reason are not in full compliance with the pertinent statutes and regulations, please so advise the undersigned.

Objection to the Claims

Applicants respectfully traverse the objection to claims 121 and 122 for containing informalities. Applicants submit that both claims 121 and 122 are proper in their current form. Claim 121 recites, "wherein rolling a portion of the film web into a

cable includes” The phrase “rolling a portion of the film web into a cable” in claim 121 refers to the step of “rolling a portion of the film web into a cable,” recited in independent claim 119, from which claim 121 depends. Claim 121 further defines that step, and as such, Applicants submit that it is proper to maintain consistency between the phrasing of the step in independent claim 119 and the phrasing of the same step in claim 121. As to claim 122, the phrase “a roping element adjacent to and downstream of the upstream guide roller” is proper because it is the first reference to that particular roping element in claims 119, 121, and 122. Accordingly, Applicants request withdrawal of the objection to the claims.

Rejections Under 35 U.S.C. § 112

Applicants respectfully traverse the rejection of claims 50, 53-55, 119-128, 129, 130, and 135-138 under 35 U.S.C. § 112, first paragraph, for failing to comply with the enablement requirement. According to the Examiner, “it is not clear in the specification what applicants referring to by the claimed ‘a first portion of the wrapping cycle’; ‘a second portion of the wrapping cycle’; or ‘from a film drive down configuration to a non-drive down configuration’?” Office Action, p. 3. Applicant’s respectfully disagree. The specification clearly describes each of the aforementioned phrases. For example, the following descriptions are included in the specification:

“Upstream guide roller 132 is positioned and configured to engage . . . the film web 112 . . . and may act to guide or drive a potion of the film web from a first level to a second lower level” (emphasis added). Specification, paragraph 76;

“Downstream guide roller 137 is positioned and configured to engage . . . the film web 112 . . . and guide or drive a portion of the film web from a first level to a second lower level” (emphasis added). Specification, paragraph 082;

"Downstream guide roller 137 is selectively engageable with the film web 112, i.e., downstream guide roller 137 can be selectively positioned to engage . . . the film web" (emphasis added). Specification, paragraph 083;

"as the dispenser 102 moves vertically upward on the vertical structure to wrap the load, the lever 140 is released, disengaging downstream guide roller 137, and when the dispenser returns to the bottom of the vertical structure at the end of the wrap cycle as the base of the load and pallet are being wrapped, the lever 140 is engaged, moving the downstream guide roller 137 into engagement with the film web being dispensed" (emphasis added). Specification, paragraph 085; and

"Downstream guide roller 137 may act as means to drive film web 112 to an elevation below the top 126a of pallet 126. Downstream guide roller 137 may alternatively combine with upstream guide roller 132 to form means for driving the film to that elevation Alternatively, upstream guide roller 132 may not act to drive the film down, i.e., may not be tilted, and only downstream guide roller 137 will drive the film downward" (emphasis added). Specification, paragraph 087.

The above-cited paragraphs of the specification are exemplary and make clear that the wrapping cycle includes a sequence of events that take place during wrapping of the load, and thus, a portion of the wrapping cycle includes any portion of that sequence. The above-cited paragraphs also make clear that the drive down configuration describes a guide roller's configuration when it is driving the film web from a first level to a second lower level, and the non-drive down configuration describes the guide roller's configuration when it is not driving the film web from the first level to the second lower level. Additional support for what the Examiner alleges is unclear can be found throughout the specification and drawings. Thus, Applicants request the withdrawal of the rejection under 35 U.S.C. § 112, first paragraph.

Applicants respectfully traverse the rejection of claims 50, 53-55, 119-128, 129, 130, and 135-138 under 35 U.S.C. § 112, second paragraph, for being indefinite for

failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

As discussed above with respect to the rejection under 35 U.S.C. § 112, first paragraph, Applicants submit that the scope of the subject matter in claims 50, 53-55, 119-128, 129, 130, and 135-138 can be determined by one having ordinary skill in the art by reviewing the specification and drawings, and thus, the rejection of these claims under 35 U.S.C. § 112, second paragraph, is improper. See M.P.E.P. § 706.03(d). In particular, Applicants believe that the meaning of the phrases “first portion of the wrapping cycle,” “second portion of the wrapping cycle,” and “from a film drive down configuration to a non-drive down configuration,” is not vague, indefinite, or confusingly worded, and is described clearly in the specification. Applicants also wish to remind the Examiner that “a fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.” M.P.E.P. § 2173.01. For at least these reasons, Applicants request withdrawal of the rejection under 35 U.S.C. § 112, second paragraph.

Rejection Under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of independent claims 119 and 129 under 35 U.S.C. § 103(a) as being unpatentable over Thimon in view of Casteel. Independent claims 119 and 129 recite, *inter alia*, “driving at least a portion of the film

web from a first elevation to a second elevation . . . with at least one of an upstream guide roller and a downstream guide roller.”

On page 4 of the outstanding Office Action, the Examiner asserts that, “Thimon discloses . . . driving at least a portion of the film web from a first elevation to a second elevation . . . with at least one of an upstream guide roll and a downstream guide roll (Fig. 5; via rollers 62, 63, 37, and 38).” However, contrary to the Examiner’s assertion, Thimon does not teach or suggest the use of rollers for the purpose claimed by Applicant. Rather, Thimon discloses that “the deviating and vertical-offsetting means 27 comprise at least two rods 37, 38 for returning and guiding the band of film 5,” and “two return and guide rods 37, 38 . . . having an outer surface capable of permitting the sliding of the band of film,” (emphasis added). Thimon, col. 10, lns. 40-45; and col. 11, lns. 21-25. The fact that the film slides on the outer surfaces of rods 37, 38 indicates that the rods do not actively engage and drive the film as required by the claims. Instead, the film passively slides down rods 37 and 38. Further, rods 37 and 38 are not rollers, as claimed. Although Thimon discloses rollers 62 and 63, neither of those rollers drives film 5 “from a first elevation to a second elevation,” as recited in independent claims 119 and 129. An example of active engagement and driving of a portion of film by a roller is described at least in FIGS. 2B, 5A, and 5B, and in paragraph 89, of Applicants’ specification, where roller 132 grips a portion of film on its outer surface and then rotates. Since the portion of film maintains contact with roller 132 during its rotation, roller 132 actively rotates the portion of film from a first elevation to a second lower elevation. Casteel fails to remedy this deficiency of Thimon, nor does the Examiner rely on Casteel for such a teaching. Therefore, the combination of Thimon

and Casteel does not establish a *prima facie* case of obviousness. Reconsideration is requested.

Accordingly, for at least the above reasons, Thimon or Casteel, taken alone or in combination, does not teach or suggest the invention as set forth in independent claims 119 and 129, and therefore Applicants respectfully request withdrawal of the rejection of independent claims 119 and 129 under 35 U.S.C. § 103(a), and the timely allowance thereof.

Claims 50, 53-55, 120-128, and 130-140 depend either directly or indirectly from one of independent claims 119 and 129, and therefore are allowable for at least the same reasons that independent claims 119 and 129 are allowable. In addition, at least some of these claims recite unique combinations that are neither taught nor suggested by the cited art, and are therefore also separately patentable.

Also, claim 53 recites, *inter alia*, that “at least one of the upstream and downstream guide rollers is coated.” Although neither Thimon nor Casteel teaches or suggests this claim limitation, the Examiner takes Official Notice, and asserts that “such guiding rollers to guide a web is old, well known, and available in the art.” Office Action, p. 6. Applicants submit that the Examiner’s taking of Official Notice is improper because the use of coat guide rollers 37 and 38, in an apparatus such as that disclosed in Thimon, is not something capable of such instant and unquestionable demonstration as to defy dispute. See M.P.E.P. § 2144.03. If the Examiner maintains this rejection, Applicants request that evidence be provided in support of the Examiner’s assertion.

The Office Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.

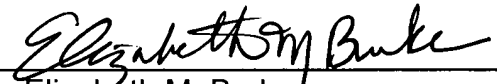
In view of the foregoing remarks, Applicants submit that this claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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